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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/972,032	10/05/2001	Monica Montano	27708/04003	2885
24024	7590	02/27/2008	EXAMINER	
CALFEE HALTER & GRISWOLD, LLP 800 SUPERIOR AVENUE SUITE 1400 CLEVELAND, OH 44114			YU, MISOOK	
ART UNIT	PAPER NUMBER		1642	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/972,032	<b>Applicant(s)</b> MONICA MOTANO
	<b>Examiner</b> MISOOK YU	<b>Art Unit</b> 1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

#### Status

1) Responsive to communication(s) filed on 07 February 2005 and 08 May 2006.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 5-10 and 23-25 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 9,10,24 and 25 is/are allowed.

6) Claim(s) 5-8 is/are rejected.

7) Claim(s) 23 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 2/7/05

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

Claims 5-10 and 23-25 are pending and under consideration.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Objections***

The objection of claim 10 of record is withdrawn in view of the amendment. However, claim 8 is newly objected because the added portion of claim, i.e. line 4, there is no space between "1or".

### ***Claim Rejections - 35 USC § 101, Withdrawn***

The rejection of claims 9, and 10 under 35 USC 101 because the claimed invention is directed to non-statutory subject matter is withdrawn in view of the amendment.

### ***Claim Rejections - 35 USC § 112***

The rejection of claims 5-7 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is **withdrawn** in view of the amendment.

Claims 6 and 7 **remain rejected** under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

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had possession of the claimed invention. This written description rejection is made because the claims are interpreted as drawn to genus of nucleic acid molecules.

Applicant argues that claim 6 has been amended to recite a polynucleotide that encodes a protein that interacts with and activates the estrogen receptor and progesterone receptor.

This argument has been fully considered but found unpersuasive because claim 6 still recites 85%. Amending the claim to recite "95%" would obviate this rejection.

The rejection of claims 5-7, 9, and 10 under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for SEQ ID NO:1, and nucleic acid encoding SEQ ID NO:2 protein, does not reasonably provide enablement for any other nucleic acid molecules is **withdrawn** in view of the amendment.

#### ***Claim Rejections - 35 USC § 102***

Claims 5, 7, and 8 remain rejected under 35 U.S.C. 102(b) as being anticipated by GenBank accession number AA687318.

Applicant argues that GenBank accession number AA687318 does not disclose an isolated polynucleotide comprising a nucleic acid sequence encoding a protein comprising SEQ ID NO:2 or a polynucleotide whose sequence is the complement of such nucleic acid sequence, as recited in claim 5 as amended, or a sequence which is complementary to SEQ ID NO: 1 or the protein encoding portion of SEQ ID NO: 1, as recited in claim 8 as amended Lacking such a disclosure, GenBank accession number AA687318 does not anticipate claim 8.

These argument has been fully considered but found unpersuasive because "the complement" in claim 5 and "a sequence which is complementary" in claim 8 are broadly interpreted to partially complementary.

GenBank accession number AA687318 teaches an isolated nucleic acid that matches 100 % to nucleotide # 741 to # 965 (total 224 nucleotides) of instant SEQ ID NO:1 and it is in pT7T3D-Pac vector, which means double stranded cDNA containing the complement of the instant SEQ ID NO: 2.

***Allowable Subject Matter***

Claims 9, 10, 24 and 25 allowed. Claim 23 is objected because it depends on the rejected base claim.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to MISOOK YU whose telephone number is 571-272-0839. The examiner can normally be reached on 8 A.M. to 5:30 P.M., every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms can be reached on 571-272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MISOOK YU  
Primary Examiner  
Art Unit 1642

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